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In re Application of
BURKE *et al*
U.S. Application No.: 10/567,635
PCT No.: PCT/US2004/025005
Int. Filing Date: 03 August 2004
Priority Date: 08 August 2003
Docket No.: 257122/0092
For: IMPROVED ANTHELMINTIC
FORMULATIONS

DECISION

This is a decision on the papers filed 21 November 2007 which are treated as a second renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 25 September 2007, a decision dismissing applicants' renewed petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available.

On 21 November 2007, applicants filed the subject response.

DISCUSSION

As previously indicated, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Items (1) and (2) were completed in the prior petition.

Regarding item (3), the 37 CFR 1.47(a) applicants provided the last known address for Mr. Tripathi as 23 The Hawthorns, Summerhill, Nenagh, Co. Tripperary, Ireland. The last known address of Mr. Burke is provided as Barrack Street, Loughrea, CO. Galway, Ireland.

Concerning item (4), the declaration signed by two of the four joint inventors was not accepted as the citizenship of the nonsigning inventors were not listed. The prior decision noted that a new declaration was required.

In the renewed petition, the 37 CFR 1.47(a) applicants argue that the requirement of citizenship "is improper since strict adherence cannot be required for every item of 37 C.F.R. § 1.497(a) when the declaration pursuant to 37 C.F.R. § 1.47 is not signed by all inventors." Moreover, petitioners claim that "[c]itizenship is not information privy to the two signing inventors such that executing a declaration in which the signing inventors state, upon potential fine or imprisonment, that all statements true to their knowledge is inappropriate." As such, a declaration listing the citizenship of each inventor was not provided.

This is not an appropriate response.

Section 409.03(a)(A) of the MPEP discusses situations where there is an unavailability of inventors and at least one joint inventor is available. It states, in part:

All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 02, § 605.01, and § 1414) and **(2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64.**

37 CFR 1.64(b) requires the inventor **upon information and belief**, to state the facts which the inventor is required to state. 37 CFR 1.497(b) is the equivalent rule in national stage applications under 35 U.S.C. 371. The citizenship of each inventor is a requirement that must be provided on each declaration. 37 CFR 1.497(a)(3).¹

An executed declaration signed on behalf of the nonsigning inventors listing the citizenship of each inventor must be provided.² Item (4) of 37 CFR 1.47(a) is still not satisfied.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision.

¹ It is noted that the citizenship of Vinay Tripathi is listed on the PCT Request as India, and the citizenship of Michael Burke is recorded as Ireland.

² Petitioners also have the option to file under 37 CFR 1.47(b), if the inventors are unwilling to sign a declaration listing the citizenship of each inventor. See § 409.03(b) MPEP.

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Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to (571) 273-0459, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450.

A handwritten signature in black ink that reads "James Thomson". The signature is fluid and cursive, with the first name "James" and last name "Thomson" clearly distinguishable.

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